REMARKS

This responds to the Office Action mailed on <u>March 24, 2008</u>.

Claim 10 is amended, claims 17-18 are canceled in this response, claim 19 having been previously canceled, and claims 29-30 are added; as a result, claims 1-16 and 20-30 are now pending in this application. Claim 10 has been amended to correct a minor typographical error and is not in response to any art based rejection or other reason related to patentability. Applicant has canceled claims 17-18 without prejudice or disclaimer in order to reduce prosecution issues thereby expediting prosecution. Applicant reserves the right to introduce claims 17-19 in a continuing application.

§103 Rejection of the Claims

Claims 1-18 and 20-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinek et al. (U.S. Patent 7,043,641). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.,* 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City,* 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine,* 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka,* 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson,* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made

explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Applicant further notes that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. (emphasis added). The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Applicant respectfully traverses the rejection. In view of the differences between Applicant's claims at issue and the cited references, Applicant respectfully submits the claims are not obvious in view of Martinek.

Concerning claims 1, 23, and 24

Claim 1 recites "authenticating a gaming terminal's identity", and further recites "when the gaming terminal's identity is authenticated, then: applying an encryption technique to encrypt a gaming software program, which produces an encrypted gaming software program." Claims 23 and 24 recite similar language. The Office Action states that Martinek, at column 10, lines 19-27 discloses authentication a gaming terminal's identity. Applicant respectfully disagrees with this interpretation of Martinek. The cited section of merely states:

> Although code verification of the gaming program shared objects has been described in detail above, code verification utilizing hash functions and signatures can be applied to verifying the authenticity of the linux kernel, modular modifications to the kernel, the operating system, game state data, random number generation data and the like. As added security, the present invention contemplates zeroing out all unused RAM to verify that no data in the form of code or other data was intentionally or unintentionally inserted. (emphasis added)

Thus it is clear that Martinek is referring to verification of code and data for gaming program software. Each of the items described are code and/or data (e.g., kernel, operating system, game state data, etc.). Nowhere does Martinek teach that a gaming terminal's identity is authenticated. The difference is significant in that verification of a terminal's identity may be used to prevent critical software from being loaded onto an unauthorized terminal, thus adding protection to the system in addition to any protection that may be afforded by verifying code and/or data.

Furthermore, Martinek does not disclose encryption or transmission of encrypted gaming software conditioned on a successful authentication of the identity of a gaming terminal.

In view of the above, Martinek does not disclose each and every element of claims 1, 23, and 24, thus there are significant differences between the claims and Martinek. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 23 and 24.

Concerning claim 10, 23, and 25

Claim 10 recites "authenticating a gaming system server's identity" and further recites "when the gaming server's identity is authenticated, then: receiving an encrypted gaming software program from the gaming system server." Claims 23 and 25 recite similar subject matter. The Office Action states that Martinek, at column 6, lines 38-50 discloses authenticating a gaming system server. Applicant respectfully disagrees with this interpretation of Martinek. The cited section states:

> Encryption of <u>data</u> via a public key/private key system is useful not only for producing digital signatures, but also for encryption of data before sending or storing the data or to keep <u>data</u> secure or secret in other applications. Similarly, symmetric encryption techniques which rely on encryption and decryption of the same single secret key may be applied to such applications. For example, <u>transmission of program data</u> between a network server and a computerized wagering game apparatus may be secured via a symmetric encryption technique, and the program data received in the game apparatus may be verified as approved by a regulatory agency via a digital signature employing hash functions and public key cryptography before execution. (emphasis added)

Again, it is clear that Martinek is disclosing secure transmission of data. Applicant cannot find in the cited portions of Martinek any disclosure "authenticating a gaming system server's identity" and "when the gaming server's identity is authenticated, then: receiving an encrypted gaming software program from the gaming system server; and applying a decryption technique to decrypt the encrypted gaming software program, which produces a gaming software program", as presently recited in claim 10, and similarly recited in claims 23 and 25. Instead, as discussed above, Martinek is apparently directed to software (e.g., code and data) authentication and validation. Thus, because Martinek does not disclose or describe every element of claims 10, 23, and 25, Applicant respectfully requests reconsideration and the withdrawal of the rejection of these claims.

Concerning claims 20 and 22

Claims 20 and 22 recites elements related to digitally signed random data. For example, claim 20 recites "transmitting digitally signed random data, the digitally signed random data comprising randomly generated data and a third digital signature, the third digital signature formed by encrypting a one-way hash with the second private-key of the associated second public-key private-key key pair, the one-way hash formed from the randomly generated data." Claim 22 recites "receiving digitally signed random data from the gaming terminal, the digitally signed random data comprising randomly generated data and a second digital signature, the second digital signature formed by encrypting a one-way hash with the private-key of the associated public-key private-key key pair, the one-way hash formed from the randomly generated data." The Office Action states on page 8 various elements of claims 20 and 22 that are asserted to be found in Martinek. However, the Office Action fails to include in these elements the recitation of any elements related to digitally signed random data. The Office Action does not identify anything in Martinek that corresponds to operating on digitally signed random data. Further, Applicant has reviewed the cited portions of Martinek, and cannot find any disclosure or description of the use of digitally signed random data. As a result, Martinek does not disclose every element of claims 20 and 22. Therefore Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 20 and 22. If the Examiner intends to maintain the rejection, Applicant respectfully requests specific identification of where in any cited reference, each element in claims 20 and 22 may be found, including any elements related to the use of digitally signed random data.

Concerning claim 21

Claim 21 recites "validating a location of the server if the digital signature of the signed digital certificate is valid." The Office Action states on page 5 various elements of claim 21 (along with now canceled claims 17-18 and pending claims 23-25) that are asserted to be found in Martinek at columns 6, 10, 11:36-48 and 12:25-39. However, the Office Action fails to include in these elements the recitation of "validating a location of the server if the digital signature of the signed digital certificate is valid." The Office Action does not identify anything in Martinek that corresponds to validating a location. Further, Applicant has reviewed the cited portions of Martinek, and cannot find any disclosure or description of validating a location of a server. Thus, because Martinek does not disclose every element of claim 21, Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 21. If the

Examiner intends to maintain the rejection, Applicant respectfully requests specific identification of where in any cited reference, each element in claim 21 may be found, including "validating a location of the server if the digital signature of the signed digital certificate is valid."

Concerning dependent claims 2-9, 11-16 and 26-28

Dependent claims 2-9, 11-16 and 26-28 depend from independent claims 1 and 10 either directly or indirectly, and accordingly inherit and incorporate the features of these independent claims. These dependent claims are accordingly believed to be patentable for at least the reasons stated herein regarding their respective base claims. Thus, Applicant respectfully requests withdrawal of the rejection of these claims.

Concerning New Claims 29-30

Claims 29 and 30 have been added in this response. Support for claims 29-30 may be found throughout the specification, and in particular on page 42, lines 14-28 of the specification. Applicant believes no new matter has been introduced in claims 29 and 30.

Claims 29 and 30 depend from claims 10 and 21 respectively, and are therefore allowable for at least the reasons discussed above regarding their respective base claims 10 and 21.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action; however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.
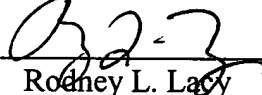
AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE   **Page 15**
Serial Number: 10/824,930   Dkt: 1842.047US1
Filing Date: April 15, 2004
Title: SECURED NETWORKS IN A GAMING SYSTEM ENVIRONMENT

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney 612-371-2134 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.
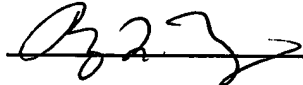
Respectfully submitted,

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Date _July 24, 2008_   By _____

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this __24th__ day of July 2008.

Rodney L. Lacy _____   _____

Name   Signature